

REMARKS

In the present Amendment, claim 1 has been amended to incorporate the subject matter of claim 5. Claims 4 and 5 have been canceled, accordingly.

No new matter has been added and entry of the Amendment is respectfully requested. Upon entry of the Amendment, claims 1-3 and 6-17 will be all the claims pending in the application.

I. Response to Double Patenting

In Paragraph No. 4 of the Action, claims 1-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-18 of copending Application No. 10/809,389 (Nakao).

In response, Applicants submit herewith a Terminal Disclaimer. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the provisional double patenting rejection.

II. Response to Rejections Under 35 U.S.C. § 102

1. In Paragraph Nos. 6 and 7 of the Action, claims 1-4 and 8-17 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Uetani et al (US 2001/0044070 A1).

Applicants respectfully submit that the present claims are novel over Uetani et al. Specifically, in the presently claimed invention, an amount of the acrylic acid ester is specified. Moreover, the composition according to the presently claimed invention contains a specific resin wherein the structure thereof is defined and a specific solvent. Uetani et al does not specifically disclose the combination of the above-mentioned features of the presently claimed invention.

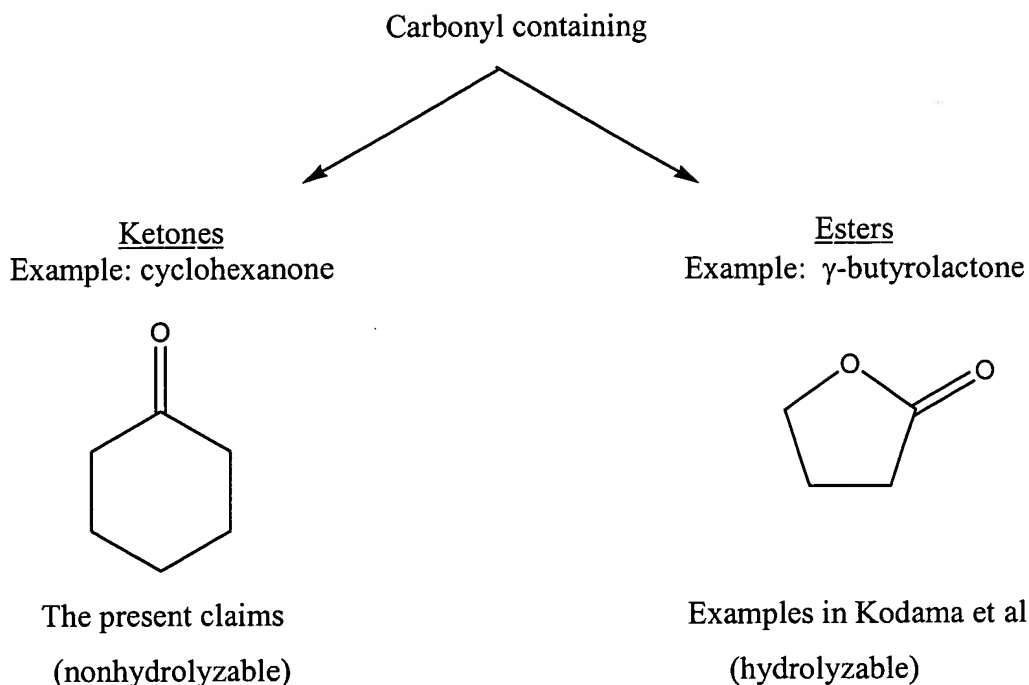
Further, we disagree with the Examiner's assertion that 2-ethyl-2-adamantyl methacrylate meets the limitations of present claim 8. Claim 8 recites that the resin (A) contains a repeating unit having an alkali-soluble group protected by a 1-adamantyl-1-alkyl group, which is different from a 2-alkyl-2-adamantyl group. See the present specification at page 42, first full paragraph.

Additionally, as noted above, Applicants have amended claim 1 to incorporate the subject matter of claim 5, which is not included in this rejection. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection over Uetani et al.

2. In Paragraph No. 8 of the Action, claims 1-2, 4-5 and 9-17 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Kodama et al (U.S. Pat. No. 6,858,370).

Applicants respectfully submit that the present claims are novel over Kodama et al for at least the following reasons.

In Example IV-44 of Kodama et al, relied upon by the Examiner, γ -butyrolactone (S7) was used as one component of the solvent mixture. However, γ -butyrolactone is different from a cyclic ketone in the present claims as shown in the chart below:



Moreover, the photoacid generator compound (II-10) of Kodama et al, relied upon by the Examiner, is not a phenacyl sulfonium salt compound.

Further, Resin 85 of Kodama et al contains only 24 mole % of the repeating units originated in an acrylic acid ester derivative (Table 6 at column 160 of Kodama et al), which does not fall within the range recited in present claim 2.

The examples described in Kodama et al which may be close to the present claims, are Example I-9 (resin (9)), Example I-49 (resin (49)), Example III-9 (resin (9)), Example III-29 (resin (29)) and Example III-49 (resin (49)). In these examples, cyclohexanone (A5) was used as one component of the solvent mixture. However, the resins in these examples do not contain a repeating unit having a group represented by the formula (V-1), (V-2), (V-3) or (V-4) recited in the present claims.

In view of the foregoing reasons, Applicants respectfully submit that the present claims are not anticipated by Kodama et al and thus the rejection should be withdrawn.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

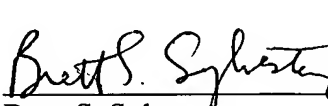
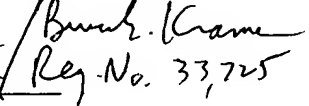
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